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REMARKS

Claims 1-4 are presently pending in the captioned application with claims 1-4 being currently amended.

Claims 1-4 have been amended into method claims. Support for the amendments can be found in Example 2 on pages 15-16 and Table 6 on page 17 of the specification. Example 2 shows that the presently claimed formulation of claim 1 can impart a defoaming property to a melamine resin-curing clear paint. No new matter within the meaning of § 132 has been added by any of the amendments.

Accordingly, Applicants respectfully request the Examiner to enter the amendments and reconsider and allow all claims pending in this application in view of the following arguments.

1. Rejection of Claims 1 and 3-4 under 35 U.S.C. § 102(b)

The Office Action rejected claims 1 and 3-4 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,576,406 ("Yamamura et al."). The Office Action stated:

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Yamamura et al disclose method where the copolymer obtained from monomers comprising alkyl (meth)acrylate and reactive monomer having a group derived from isocyanate group is added to solvent borne paint (Col. 1, line 17-20, Col. 2, line 1-5, 32-36, Col. 3, line 7-8, 32, Col. 17, line 38, and Col. 26, line 59-62). Illustrated in Example 13 which discloses a copolymer obtained from 57.5% (115/200) alkyl (meth)acrylate - 10 parts of MMA, 40 parts of DMA, 19 parts of BA, 46 parts of n-butoxymethyl methacrylate, and 32.5% (65/200) - 65 parts of a methacrylic acid ester monomer possessing the following structure:



which is 2-(0-[1-methyl-propylideneamino] carboxyamino)ethyl methacrylate as presently claimed.

As to the defoamer for baking finish type top coat paint for motor vehicle in independent claim 1, the disclosure of Yamamura et al meets the requirements of instant claims both in terms of materials added and their contents. It is reasonable to presume that the composition of Yamamura et al would fulfill the same utility function of defoamer for baking finish type top coat paint for motor vehicle as presently claimed in light of its chemical similarities. The burden is shifted to applicants to establish that the product of the presently claims is not the same as or obvious as that set forth by the reference Yamamura et al.

Applicants respectfully traverse the rejection because

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Yamamura et al. does not teach the presently claimed **method** for imparting a defoaming property to baking-type top coat painting for motor vehicles. Although the reference teaches a paint comprising copolymers obtained from monomers comprising alkyl (meth)acrylates, the reference fails to teach the specifically claimed limitation of imparting a defoaming property to a baking-type top coat paint by adding the presently claimed copolymers.

Rule of Law

Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Those elements must be expressly disclosed as in the claim. In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990).

But where the claims are drawn to a new method of using either an old or "obvious" composition, wherein the method has unobvious beneficial or useful effects, the new method claims are patentable even though the composition itself could not be patented. Rohm and Haas Company v. Dawson Chemical Company, Inc. et al., 217 USPQ 515 (D.C. S. Texas 1982) (citing In re Shetty, 566 F.2d 81, 195 USPQ 753 (C.C.P.A. 1977); In re Legator, 352 F.2d 377, 147 USPQ 322

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(C.C.P.A. 1965)).

Analysis

The independent claim 1 recites a method for imparting a defoaming property to a baking finish type top coat paint for motor vehicles by adding to the top coat paint a copolymer of 2-50% by weight of a reactive monomer having isocyanate group or an isocyanate-derived group with 98-50% by weight of other monomer or polymer which is reactable with said reactive monomer.

Although Yamamura et al. generally teaches a paint made of a copolymer obtained from various monomers including alkyl (meth)acrylate and reactive monomer having a group derived from isocyanate group and reactive monomer having a group derived from isocyanate group, nothing in the reference either expressly or inherently teaches or would motivate one of ordinary skill in the art to make the presently claimed method of imparting a defoaming property to a top coat paint.

Yamamura et al. only teaches that their disclosed polymers are useful for the production of paints, adhesives or sealing agents having good acid resistance. However, in the present application, Applicants claim a **method** of adding the copolymer of 2-50% by

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weight of a reactive monomer having isocyanate group or an isocyanate-derived group with 98-50% by weight of other monomer or polymer which is reactable with said reactive monomer to a top coat paint such that the presently claimed method of imparting a defoaming property is unobvious and unexpected and has beneficial and useful effects over known methods.

Accordingly, Applicants respectfully submit that the presently claimed **method** is not anticipated by Yamamura et al. and request the Examiner to reconsider and withdraw the § 102(b) rejection.

2. Rejection of Claim 2
under 35 U.S.C. § 103(a)

The Office Action rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,576,406 ("Yamamura et al.") in view of U.S. Patent No. 4,219,632 ("Simms"). The Office Action stated:

As to the component A of a polymerizable monomer having isocyanate groups being able to react with a binder resin in thermosetting paint in dependent claim 2, Yamamura et al do not teach this monomer as presently claimed. However, Simms teaches the low molecular weight isocyanato-acrylate copolymers (Title) such as isocyanatoethyl methacrylate in Examples (Col. 3-4).

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The advantage of using presently claimed isocyanate group containing monomer in the copolymers is (1) colorless liquids or solids soluble in organic solvents having molecular weights and viscosities suitable for use in coating applications, (2) also can be used as moisture-curing film former (Col. 2, line 53-62).

Therefore, it would have been obvious at time the invention was made to include the isocyanate group containing monomer of Simms in the composition of Yamamura et al in order to obtain the above-mentioned advantage.

Applicants respectfully traverse the rejection because neither Yamamura et al. nor Simms teach the presently claimed **method** for imparting a defoaming property to a baking-type top coat paint for motor vehicles. Although Yamamura et al. teaches a paint comprising copolymers obtained from monomers comprising alkyl (meth)acrylates, Yamamura et al. fails to teach the specifically claimed limitation of imparting a defoaming property to a baking-type top coat paint by adding the presently claimed copolymers.

Similarly, Simms while teaching a low molecular weight isocyanato-acrylate copolymers such as isocyanatoethyl methacrylate and the use hereof as curing agents for urethane coating compositions, nevertheless fails to teach the presently claimed method of imparting a defoaming property to top coat paints.

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Rule of Law

Where the claims are drawn to a new method of using either an old or "obvious" composition, wherein the method has unobvious beneficial or useful effects, the new method claims are patentable even though the composition itself could not be patented. Rohm and Haas Company v. Dawson Chemical Company, Inc. et al., 217 USPQ 515 (D.C. S. Texas 1982) (citing In re Shetty, 566 F.2d 81, 195 USPQ 753 (C.C.P.A. 1977); In re Legator, 352 F.2d 377, 147 USPQ 322 (C.C.P.A. 1965)).

Analysis

The independent claim 1 recites a method for imparting a defoaming property to a baking finish type top coat paint for motor vehicles by adding to the top coat paint a copolymer of 2-50% by weight of a reactive monomer having isocyanate group or an isocyanate-derived group with 98-50% by weight of other monomer or polymer which is reactable with said reactive monomer. However, Yamamura *et al.* and Simms both fail to teach the presently claimed method for imparting a defoaming property to a top coat paint.

Although Yamamura *et al.* generally teaches a paint made of a copolymer obtained from various monomers including alkyl

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(meth)acrylate and reactive monomer having a group derived from isocyanate group and reactive monomer having a group derived from isocyanate group, nothing in the reference either expressly or inherently teaches or would motivate one of ordinary skill in the art to make the presently claimed method of imparting a defoaming property to a top coat paint.

Notably, the defoaming property claimed by the present invention is not a property inherent to any of the copolymers taught by Yamamura *et al.* and as such would have failed to lead an ordinarily skilled artisan within the art to make the presently claimed limitations. Yamamura *et al.* only teaches that their disclosed polymers are useful for the production of paints, adhesives or sealing agents having good acid resistance.

However, in the present application, Applicants claim a **method** of adding the copolymer of 2-50% by weight of a reactive monomer having isocyanate group or an isocyanate-derived group with 98-50% by weight of other monomer or polymer which is reactable with said reactive monomer to a top coat paint such that the presently claimed method of imparting a defoaming property is unobvious and unexpected and has beneficial and useful effects over known methods.

Similarly, Simms teaches an additive for paint that is a

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copolymer obtained from 25-75 % C₂-C₂₂ alkyl (meth)acrylate and 25-75 % 2-isocyanate ethyl methacrylate wherein nothing in Simms relates to a method for imparting a defoaming property to a top coat paint. Hence, Simms fails to teach each and every claimed limitation of presently pending claim 1 as does Yamamura *et al.*

Accordingly, Applicants respectfully submit that the presently claimed invention is not obvious over Yamamura *et al.* in view of Simms and request reconsideration and withdrawal of the § 103(a) obviousness rejection.

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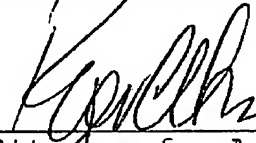
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CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection of the pending claims and allow the pending claims. Favorable action with an early allowance of the claims pending is earnestly solicited.

Respectfully submitted,

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